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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,564	04/17/2001	Ikko Kawauchi	003510-092	5901

7590

07/30/2003

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EXAMINER

WALKE, AMANDA C

ART UNIT

PAPER NUMBER

1752

7

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-2

**Office Action Summary**

Application No.

09/835,564

Applicant(s)

KAWAUCHI, IKUO

Examiner

Amanda C Walke

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1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,14,18 and 19 is/are allowed.
- 6) ☒ Claim(s) 11,12,15-17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 11, 12, 15, 16, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimazu et al (6,294,311).

Shimazu et al disclose a lithographic printing plate having high chemical resisittance comprising a substrate, an underlayer, and a top layer. The alkaline soluble underlayer comprises a combination of polymeric materials and infrared absorbing materials (photothermal conversion materials). Preferably the infrared absorbing materials are dyes or pigments such as carbon black (column 3, lines 41-51, column 4, line 24 to column 6, line 12, and column 6, line 25- column 7, line 9). The preferred infrared absorbing material is a dye used in the examples, and is the same as the presently claimed dye (1). A preferred solvent for use in the material is a mixture of methanol/dioxolane/methyl lactate (43:43:14) wherein the only high boiling point solvent (as defined by the present invention) is the methyl lactate, which comprises only 14 % by wt of the solvent mixture (and is used in the examples of the reference). The underlayer is formed by coating the layer onto the substrate then drying it. The plate if the reference is preferably a positive-working plate (column 15, lines 25-30). It is the position of the examiner

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that the underlayer meets the limitations for the presently claimed photosensitive layer until the “top layer” is added, thus the substrate coated with only the under layer is an isolated intermediate product and is still a precursor to a printing plate,

With respect to the “dissolved or dispersed...200 ° C” in claims 11 and 12, this is a product by process limitation. The product consists of a printing plate precursor comprising a photosensitive layer which contains a cyanine dye and a polymer insoluble in water and soluble in aqueous alkali solution, not what the solvent system consisted of during the process of making the product. M.P.E.P. § 2113:

3. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)... “The Patent Office bears a lesser burden proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. *In re Fessman*, 180 USPQ 324, 326 (CCPA 1974). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

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***Allowable Subject Matter***

4. The following is a statement of reasons for the indication of allowable subject matter: Claims 13, 14, 18, and 19 are indicated as containing allowable subject matter. The prior art of record fails to teach or suggest to one of ordinary skill in the art to prepare a positive-type planographic printing plate described by the present claims 13 or 18 (14 and 19 are dependent upon them) wherein of the residual solvent is contained in the photosensitive layer, 50% by weight or more of the solvent consists of solvent having a boiling point lower than 100 degrees C.

***Response to Arguments***

5. Applicant's arguments filed 5/12/2003 have been fully considered but they are not persuasive.

Applicant argued that the references failed to teach that the Shimazu et al reference fails to teach a photosensitive top layer. As explained above, it is the position of the examiner that the underlayer meets the limitations for the presently claimed photosensitive layer until the "top layer" is added, thus the substrate coated with only the under layer is an isolated intermediate product and is still a precursor to a printing plate,

Applicant's arguments with respect to the Lewis et al reference were persuasive, and it was determined that the reference did not read obviate the newly presented claims.

In light of applicant's amendments the specification objections and the 35 USC 112 rejections are no longer pertinent.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

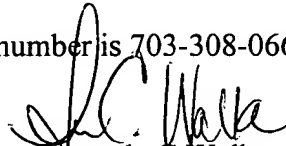
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

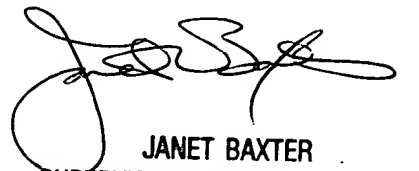
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Amanda C Walke  
Examiner  
Art Unit 1752

ACW  
July 28, 2003



JANET BAXTER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700